

REMARKS

Claims 1-7, 9, 20-23 and 27-33 are pending in the instant application. Claims 1-7, 9, 20-23 and 27-33 have been rejected. Claims 2 and 5 have been amended. Support for these amendments can be found in the specification. Claims 1, 7, 9, 20-23 and 27-33 have been cancelled. After entry of these arguments, Claims 2-6 will remain pending.

Rejection of Claims 7, 9, 20-23 and 27-33 under 35 USC §112, first paragraph

The Examiner has rejected Claims 7, 9, 20-23 and 27-33 under 35 USC §112, first paragraph as allegedly lacking enablement. The Examiner alleges that the specification is only enabling for a method of treating ovarian carcinoma.

Applicants respectfully traverse this rejection. Applicants believe that the specification is enabling for the entire scope of the claimed invention. However, without conceding the correctness of the Examiner's rejection, but to advance the prosecution of the instant application, Applicants have cancelled Claims 7, 9, 20-23 and 27-33. Accordingly, this rejection should be rendered moot and Applicants respectfully request the rejection of Claims 7, 9, 20-23 and 27-33 under 35 USC §112, first paragraph, be withdrawn.

Rejection of Claims 1, 5, 7, 9, 20-23 and 27-33 under 35 USC §102(b)

The Examiner has rejected Claims 1, 5, 7, 9, 20-23 and 27-33 under 35 USC §102, first paragraph as allegedly lacking novelty in light of Staskun et al., Shchavlinskii et al., Arai et al., and Agarwal et al.

Applicants respectfully traverse this rejection. However, without conceding the correctness of the Examiner's rejection, but to advance the prosecution of the instant application, Applicants have cancelled Claims 1, 7, 9, 20-23 and 27-33, and have amended Claim 5 to depend from Claim 2. Accordingly, this rejection should be rendered moot and Applicants respectfully request the rejection of Claims 1, 5, 7, 9, 20-23 and 27-33 under 35 USC §102(b), be withdrawn.

Commonly Owned Subject Matter

Applicants contend that the subject matter of the various claims was commonly owned at the time the inventions contained therein were made.

Rejection of Claims 1-7, 9, 20-23 and 27-33 under 35 USC §103(a)

The Examiner has rejected Claims 1-7, 9, 20-23 and 27-33 under 35 USC §103(a) as allegedly being unpatentable over Agarwal et al., WO03/084938. The Examiner alleges that Agarwal teaches a generic group of pyrimidi-4-one compounds which embrace the compounds of the instant application. The Examiner admits that Claims 2-4 and 6 differ from the reference by reciting a more limited subgenus, but suggests that a skilled chemist would have a reasonable expectation that the species would have similar properties.

Applicants respectfully traverse this rejection. The compounds in Agarwal are "useful for the treatment of inflammation and immunological diseases" (see the specification on page 1, lines 15-16). Specifically, the compounds are inhibitors of cytokines, such as IL-6 and COX-2. The assays contained in the specification are directed to testing the compounds for anti-inflammatory properties; for example the Rat Carrageenan Paw Edema Test on page 29, the assay directed to the *In vitro* Evaluation of Cyclooxygenase-2 (COX-2) Inhibition Activity on page 20, the Interleukin-6 (IL-6) assay on page 31 and the Inhibitory Action on Adjuvant Arthritis assay on page 31. Conversely, the compounds of the instant application are inhibitors of KSP and useful for the treatment of cancer. The instant application contains assays directed to measuring the claimed compounds' ability to arrest cells in mitosis and induce apoptosis (see specification pages 34-37). One skilled in the art would not expect that compounds useful for the treatment of inflammation would be useful to inhibit KSP.

Furthermore, the compounds disclosed in Agarwal and the compounds of the instant application are structurally distinct. While the pyrimidone cores are similar, the substitution patterns differ. The compounds in Agarwal require a sulfur group off of one of the phenyl groups, while the compounds of the instant invention do not require or suggest such substitution. In fact, all of the exemplified compounds in Agarwal contain a sulfur moiety (see pages 25-28).

Because the compounds in Agarwal are useful for the treatment of a different disease state and require distinct substitution, one skilled in the art would not be motivated to make the compounds of the instant invention after reading Agarwal.

In light of the above arguments and claim cancellations, Applicants respectfully request that the rejection of Claims 1-7, 9, 20-23 and 27-33 be withdrawn.

If a telephonic communication with the Applicants' representative will advance the prosecution of the instant application, please telephone the representative indicated below. Applicants believe no additional fees are due but the Commissioner is authorized to charge any fees required in connection with this response to Merck Deposit Account No. 13-2755.

Respectfully submitted,

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